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In re application of: :
NAGESH S. KOMMAREDDI, et al. :
Serial No.: 09/900,342 : Group Art Unit: 1714
Filed: July 5, 2001 : Examiner: Tae H. Yoon
For: MICROENCAPSULATED AND : Docket No.: 194-12047-US
MACROENCAPSULATED DRAG : Date: November 3, 2003
REDUCING AGENTS :

RESPONSE TO RESTRICTION REQUIREMENT UNDER 35 U.S.C. §121

Mail Stop Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

In reply to the Restriction Requirement dated October 10, 2003, setting a shortened statutory period for reply of one month, please enter the following response.

Restriction Requirement

The Examiner has required restriction to one of the following inventions under 35 U.S.C. §121:

- I. Claims 1-7, 13-24, 29-39, 45-56 and 61-64, drawn to a core shell polymer and a method of making, classified in Class 523 and 524, subclass 200+ and 504+.
- II. Claims 25-28 and 57-60, drawn to a blend of drag reducers, classified in Class 523, subclass 175+.

I hereby certify that this correspondence, and any attachments referred to, is being facsimile transmitted to the USPTO at 703/872-9310, on

NOVEMBER 3, 2003
Date


David L. Mossman

III. Claim 65, drawn to a method of making a particulate compound, classified in Class 523 and 524, subclass 200+ and 504+.

IV. Claim 66, drawn to a method of making a particulate compound, classified in Class 523 and 524, subclass 200+ and 504+.

The inventions are alleged to be distinct, each from the other because of the following reasons:

The Examiner contends that inventions I and III and IV are related as combination and subcombination. It is noted by the Examiner that inventions in this relationship are allegedly distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP §806.05(c)). In the instant case, the Examiner contends that the combination as claimed does not require the particulars of the subcombination as claimed because the shell of Group I could have an outer diameter of less than 5000 microns and encompass polymers other than polyalpha olefin. The Examiner asserts that the subcombination has separate utility such as a rheology modifier in paints.

The Examiner contends that inventions II and I are related as combination and subcombination. The Examiner contends that inventions in this relationship are allegedly distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP §806.05(c)). In the instant case, the Examiner contends that the combination as claimed does not require the particulars of the subcombination as claimed because the core-shell polymer of Group II does not require that of Group I. The Examiner asserts that the subcombination has separate utility such as a rheology modifier in paints.

Because these inventions are allegedly distinct for the reasons given above and have acquired a supposed separate status in the art as shown by their different classification, and the search required for Group II-IV is not required for Group I-III, respectively, the restriction for examination purposes as indicated is contended to be proper.

The Examiner notes that a telephone call was made to Mr. Mossman on October 7, 2003 to request an oral election to the above restriction requirement, but did not result in

an election being made. The file lists telephone no. (915) 392-8015 and a message said the area code has been changed to (325) when the examiner dialed. However, (325) 392-8015 is not in service and the PTO's PALM does not show any information regarding an attorney.

The Applicants must respectfully traverse.

The Applicants' attorney regrets that the Examiner was unable to make telephone contact with him. Approximately a year-and-a-half ago, the attorney relocated and now has the telephone number 512/219-4026. This phone number is correctly reported on the list of Patent Attorneys and Agents Registered to Practice before the U.S. Patent and Trademark Office on the USPTO Web site.

The Applicants would respectfully elect with traverse the first group of claims, Group I, claims 1-7, 13-24, 29-39, 45-56 and 61-64.

The Applicants further noted that claims 8-12 and 40-44 were omitted from any of the Examiner's Groups I, II, III or IV. In a telephone conference between the Applicant's attorney and the Examiner on October 29, 2003, the Examiner noted that these claims would be grouped together as Group V drawn to a core shell polymer having a barrier layer between the core and the shell, classified in Class 428 and subclass 403. To be clear, the Group V claims are not elected herein.

Applicants respectfully traverse the restriction requirement as not complying with the statutory law in this area. Specifically, the Examiner has made no showing that the two sets of claims are "independent *and* distinct." The law states, in 37 CFR §1.142, that:

"(a) If two or more *independent and* distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action being called a requirement for restriction ... "

While there is some difference in the way this statute is interpreted in the MPEP, it should be noted that:

"The MPEP ... is entitled to notice so far as it is an official interpretation of the statutes or regulations with which it is not in conflict." See *Litton Systems, Inc. v. Whirlpool Corp.*, 221 U.S.P.Q. 97, 107 (Fed. Cir. 1984).

As the MPEP is in *direct* conflict with the law on this point, it is not entitled to *any* weight on the matter. The Examiner only argues distinctness in the rejection.

The alleged distinct inventions herein have not been shown to be independent as required by 37 CFR §1.142. In fact, particulate compounds of the Group I claims could be made by the methods of the claims of Groups III and IV and thus are not independent therefrom. For instance, claims 1-2 and 4-7 are not limited to outer shell diameter and could easily have a monomer conversion greater than 60% (claim 65) and all of claims 1-7 could have the core be polyalpha-olefins, in the absence of molecular oxygen and hydroxyl groups (claim 66). Some of the particulate compounds falling within the claims of Group I would be made by methods of the claims of Groups III and IV; the claims of these Groups are thus not independent. Further, there is no support in the record for the Examiner's contention that the subcombination has separate utility as a rheology modifier in paints.

With respect to the claims of Groups I and II, the Examiner contends that the core-shell polymer of Group II does not require that of Group I. The Applicants respectfully submit that this is factually incorrect. For instance, claim 25 can be understood to be a narrower embodiment of claim 1, with the exception that claim 1 requires the encapsulated compound to be ground to form the particulate compound. Both claims require a core comprising the compound selected from the group consisting of polymers formed within a shell and monomers which are polymerized within the shell, where the shell is inert to monomer polymerization. Both claims require a shell encapsulating the core. Claim 25 has the further requirements of a second drag reducing agent. Again, there is no support in the record for the Examiner's contention that the subcombination has separate utility as a rheology modifier in paints.

Finally, the fact that the claims of Groups I, II, III, IV and V may fall into different search categories is irrelevant when considering the requirement of restriction. In fact, the claims of Groups I, III and IV do *not* fall into different search categories, since the Examiner has noted that claims of these Groups fall into the *same* Classes 523 and 524, and *same* subclasses 200+ and 504+. Thus, there would be no undue burden on the Examiner to search the claims of these three Groups together.

Furthermore, as the Commissioner may from time to time reorganize the Art Groups, restrictions based upon this type of reasoning would allow the Commissioner to arbitrarily decide what is and is not subject to restriction. In other words, the division of art groups does not necessarily have anything to do with divisions of technology or inventions. When a particular art group gets to be too large, a logical area to divide the group is determined. This division does not necessarily define separate inventive areas, but is arbitrary. Using the Examiner's reasoning and the example above, a restriction could be required on one day because of the separation of art groups that could not have been requested the day before. The passage of time and the arbitrary division of art groups should not enter into the restriction requirement. This is not the intent or the proper application of the restriction requirement. Reconsideration is respectfully requested.

It is respectfully submitted that the arguments presented above render the restriction requirement moot. Consideration and allowance of the claims are respectfully requested. The Examiner is respectfully reminded of his duty to indicate allowable subject matter. The Examiner is invited to call the Applicants' attorney at the number below for any reason, especially any reason that may help advance the prosecution.

Respectfully submitted,
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